



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,934	11/13/2001	Won Ku Lee	P23583	5232
7055	7590	09/22/2004	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			WILLIAMS, JAMILA O	
			ART UNIT	PAPER NUMBER
			3712	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/036,934

**Applicant(s)**

LEE, WON KU

**Examiner**

Jamila O Williams

**Art Unit**

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on amendment filed 5/27/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

The indication of allowable subject matter in the previous action has been withdrawn in view of newly cited references, see rejections below.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 11 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear from the specification how “the door of the sharing sheet has a different shape from the aperture....the background design is partially exposed when the door is closed”. According to the specification (page 5 lines 17-20) and figures (5a,b), the opening and the door are triangular and the opening can be opened and closed by the door. There is no disclosure of the door being of a different shape or that the background design is partially exposed when the door is closed (for example in figures 6e,f the window is in the open position). The examiner notes that on page 6 lines 17-19, the applicant states that the door can be modified to change the amount of exposure of the background design by changing the pivot edge but this does not

provide support for changing the shape of the door or for the background design being partially exposed when the door is closed.

***Claim Objections***

3. Claim 1 is objected to because of the following informalities: There is a lack of antecedent basis for the “at least one of background design”, recited in line 6 of the claim. The language used in claim 10 line 2 “at least one of opens and closes”, does not read clearly. A possible solution could be –opens or closes--. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1,3-4,5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by D’Andrea. D’Andrea discloses a children’s book having at least one page set bound or stapled wherein the page set comprises a pair of background sheets (12,14), each having a different design (20,22) and a sharing sheet (16) putted in between the background sheets for being coordinated with the background sheets; wherein the sharing sheet is an opaque paper having at least one opening (30) for exposing the background designs therethrough (fig 3); wherein the sharing sheet has at least one foreground design drawn on a front or rear

Art Unit: 3712

surfaces (column 3 lines 50-52 of the specification); wherein the foreground design on the surface of the sharing sheet is coordinated with the background design on each of the background sheets when the sharing sheet is folded with each of the background sheets (column 3 lines 16-18 of the specification).

Regarding the functional limitation, "used to create an image in a drawing space provided on the sharing sheet", D'Andrea is inherently capable of this function, in that the structural limitations are met.

6. Claims 12 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Feuer. Feuer discloses a book comprising at least one background sheet (14) having a background design (20) and at least one sheet provided with a drawing space (front sheet 12, has space that can inherently be used for drawing) and an aperture that exposes the background design (fig 1) and the at least one sheet is opaque (fig 1).
7. Claims 12, 15 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Wagner (cited in on a previous pto-892 mailed 2-27-04). Wagner discloses a book having at least one background sheet (6) having a background design (fig 2) and at least one sheet with a drawing space (sheet, 7, the examiner notes that there are images on these sheets but there is still empty space that can inherently serve as drawing space) and an aperture (11) that exposes the background design (fig 1); wherein the at least one sheet includes at least one foreground design (fig 2); wherein the at least one sheet is opaque (fig. 1).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Andrea or Feuer or Wagner. These references disclose all of the elements of the claims (see rejections above) but for sharing sheet comprising transparent material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the sheets of D'Andrea transparent, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Especially since the applicant states no criticality towards the material of the sheets (page 4 lines 5-7 of the specification).
10. Claims 8-11 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Andrea in view of Werzberger. D'Andrea discloses all of the elements of the claims but for the foldable door formed on the sharing sheet. Werzberger teaches having a book with a foldable flap or door (figs 1a,b, flap 22) on a sheet of a book assembly. It would have been obvious to one having

Art Unit: 3712

ordinary skill in the art at the time the invention was made to use the teaching of a foldable flap or window of Werzberger with the sharing sheet of D'Andrea for the purpose of selectively displaying the background designs.

11. Claims 13,14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feuer or Wagner in view of Werzberger. These references disclose all of the elements of the claims (see rejections above) but for the foldable door formed on the sharing sheet. Werzberger teaches having a book with a foldable flap or door (figs 1a,b, flap 22) on a sheet of a book assembly. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the teaching of a foldable flap or window of Werzberger with the sharing sheet of Feuer or Wagner for the purpose of selectively displaying the background designs.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This is simply art of interest and was not used to reject any claims in this office action.

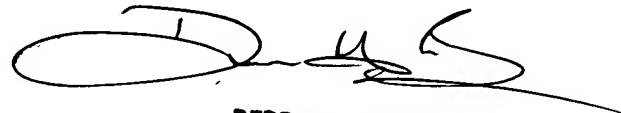
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila O Williams whose telephone number is 703-305-3312. The examiner can normally be reached on 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3712

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jw



**DERRIS H. BANKS**  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700